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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,936	12/05/2001	Herman Chien	6541-59286	9281

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EXAMINER	
SAMS, MATTHEW C	
ART UNIT	PAPER NUMBER
2617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/006,936	CHIEN, HERMAN	
	Examiner	Art Unit	
	Matthew C. Sams	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-8,10,11,14-25 and 27-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-8,10,11,14-25 and 27-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2006 has been entered.

Response to Arguments

2. Applicant's arguments filed 12/22/2006 have been fully considered but they are not persuasive.

3. In response to applicant's argument regarding claims 4 and 7 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., achieving anonymity of the subscriber (Pages 7-8)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. In response to the applicant's argument regarding claims 4, 7, 10, 14, 21 and 25 that Peck does not disclose "a anonymous user identifier is based, at least in part, on a serial number of a SIM assigned to the SIM by a manufacturer of the SIM" (Pages 7-9), the Examiner disagrees. (Examiner Note: even though the "anonymous" limitation is

not mentioned in claims 4 & 7, the examiner is arguing all the claims together because Peck meets the anonymous limitation)

Peck teaches the "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer" (Col. 8 lines 50-52), is "specific to the SIM card" (Col. 5 lines 21-23) and the "SIM-based ESN" is used for the "key-based authentication processes of the AMPS and GSM networks". (Col. 5 lines 18-33) Therefore, Peck teaches the SIM-based ESN is an anonymous user identifier because the SIM-based ESN is derived from the manufacturer of the SIM card, is used by the network in the authentication process in order to communicate with the wireless network and for reducing fraud through the validation process. (Peck Col. 3 lines 9-15 & lines 47-57)

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 4-8 and 27-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Peck (US-6,606, 491).

Regarding claim 4, Peck teaches a communication device (Fig. 1 [24] and Fig. 2) comprising a register configured to store a user identifier (Col. 2 lines 12-61), a

transmitter configured to transmit the user identifier to a network (Fig. 2 [54] and Col. 3 lines 51-57) and a SIM card (Fig. 2 [90]) wherein the user identifier is associated with a serial number that, at least in part, is assigned to the SIM by a manufacturer of the SIM. (Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 5, Peck teaches a communication device (Fig. 1 [24] and Fig. 2) that has a processor (Fig. 2 [68]) configured to encrypt at least one of the device identifier and the user identifier before transmission to the communication network. (Col. 2 lines 12-61 and Col. 7 lines 36-49)

Regarding claim 6, Peck teaches a processor (Fig. 2 [68]) and a user input interface configured to supply commands to the processor. (Fig. 2 [76])

Regarding claim 7, Peck teaches a cell phone comprising a display (Fig. 2 [78]) configured to display data and commands (Col. 6 lines 25-34), a user input interface for data entry and command entry (Fig. 2 [76]), a SIM (Fig. 2 [90]) having a SIM serial number (Col. 2 lines 49-61 and Col. 3 lines 51-57) that, at least in part, is assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") and a transmitter configured to transmit the SIM serial number to a network. (Fig. 2 [54] and Col. 7 lines 36-49)

Regarding claim 8, Peck teaches a cell phone (Fig. 2), comprising memory (Fig. 2 [86]) configured to store a device identifier (Col. 3 lines 51-57 and Col. 5 lines 18-21),

wherein the transmitter is configured to transmit the device identifier. (Col. 7 lines 36-49)

Regarding claim 27, Peck teaches a register configured to store a mobile station number and the transmitter is configured to transmit the mobile station number and the user identifier to a network. (Col. 1 lines 33-54)

Regarding claim 28, Peck teaches a mobile station number is a mobile station phone number which is the same as the MSISDN number. (Col. 1 lines 33-54)

Regarding claim 29, Peck teaches a SIM card (Fig. 2 [90]), wherein the user identifier is associated with a serial number assigned to the SIM. (Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 30, Peck teaches a register configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Col. 2 lines 30-61)

Regarding claim 31, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Col. 2 lines 30-48)

Regarding claim 32, Peck teaches the register is configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Col. 1 lines 33-54)

Regarding claim 33, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Col. 2 lines 30-48)

Regarding claim 34, Peck teaches a SIM with the user identifier associated with a serial number to the SIM. (Col. 3 lines 51-57 and Col. 4 lines 53-62)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 10, 11, 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (US-6,310,889 hereafter, Parsons) in view of Peck.

Regarding claim 10, Parsons teaches a content provider configured to communicate with one or more mobile stations (Col. 1 line 54 through Col. 2 line 32), comprising a content personalization interface configured to receive an user identifier from at least one of the mobile stations. (Col. 8 lines 56-61) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not explicitly reciting the user identifier is based on a SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable,

switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 11, Parsons in view of Peck teaches a processor configured to deliver content to the at least one mobile station based on the anonymous user identifier. (Parsons Col. 8 lines 56-61, Peck Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 14, Parsons teaches a content provider comprising a personalization interface configured to receive personalization data that is a user identifier and a processor configured to provide content to a user based on the personalization data. (Col. 2 lines 11-32 and Col. 8 lines 56-61) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not mentioning the user identifier is based on a SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 15, Parsons in view of Peck teaches a database configured to store personalization data. (Parsons Col. 4 lines 35-45)

Regarding claim 16, Parsons in view of Peck teaches the personalization interface is configured to receive personalization data associated with an HTTP header. (Parsons Col. 4 line 66 through Col. 5 line 50)

Regarding claim 17, Parsons in view of Peck teaches a personalization interface configured to receive anonymous personalization data that includes a device identifier and the processor provides device-specific content based on the device identifier. (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 18, Parsons in view of Peck teaches a personalization interface configured to receive anonymous personalization data from a mobile station. (Parsons Col. 8 line 56 through Col. 9 line 56, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 19, Parsons in view of Peck teaches the personalization interface is configured to receive the user identifier that is stored on the SIM. (Peck Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 20, Parsons in view of Peck teaches the user identifier is the SIM serial number (Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) assigned by the manufacturer of the SIM. (Peck Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 21, Parsons teaches a method of providing personalized content in a wireless communication by selecting a user identifier and selecting content based on the user identifier. (Col. 1 line 59 through Col. 2 line 32) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not mentioning the user identifier is based on a SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 22, Parsons in view of Peck teaches the user identifier selected based on the serial number of the SIM card. (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 23, Parsons in view of Peck teaches selecting a device identifier. (Peck Col. 2 lines 12-61 and Col. 7 lines 36-49)

Regarding claim 24, Parsons in view of Peck teaches comparing the device identifier and the user identifier with a set of user profiles and selecting content based on a selected user profile. (Peck Col. 2 lines 12-61, Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 25, Parsons in view of Peck teaches a method of anonymous personalized content by selecting an anonymous user identifier based, at least in part, on a serial number assigned by a SIM manufacturer to a subscriber identification module (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") and identifying content for delivery based on the anonymous user identifier. (Parsons Col. 1 line 59 through Col. 2 line 32)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS
3/5/2007

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